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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------------|
| 10/587,451 | 07/27/2006 | Ryuichiro Amano | DK-US065159 | 2263 |
| 22919 | 7590 | 12/08/2010 | | |
| GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680 | | | EXAMINER ZOLLINGER, NATHAN C | |
| | | | ART UNIT 3746 | PAPER NUMBER |
| | | | MAIL DATE 12/08/2010 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|--------------------------------------|---|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/587,451 | Applicant(s) AMANO, RYUICHIRO | |
| | Examiner NATHAN ZOLLINGER | Art Unit 3746 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See next page.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Devon C Kramer/
 Supervisory Patent Examiner, Art Unit 3746

/N. Z./
 Examiner, Art Unit 3746

Applicant has argued chiefly against the secondary references which provide the teaching of a cone-shaped recess. To begin, Examiner would like to point out the fact that the recess dimensions, as presented by the Applicant, appear to be somewhat arbitrary. In the specification filed on July 27, 2006, Applicant briefly mentions these dimensions in two locations, paragraphs 27 and 31 (width of 50% projection OD and depth of 10-15% projection OD). Beyond these numbers, however, no explanation exists as to why they were chosen or the specific benefits of choosing such dimensions. The criticality of these values is further diminished by the fact that no discussion of bordering values is present (i.e., what would happen if the width was 42% or 58% the projection OD? Would it matter?). Indeed, the lack of evidence backing up the choice of dimensions leads one ever closer to relegating the dimensions as an obvious matter of design, since applicant has not disclosed that these exact dimensions solve any stated problems or are for any particular purpose. With the criticality of the dimensions deemed questionable, Examiner now turns to the weight of Applicant's arguments. Foremost in the arguments is the observation that there is no "apparent reason" for combining any of the references. Examiner disagrees using Speakman as an example. Speakman provides an explicit motivation of using a cone-shaped recess that remains after crushing to later act as an identifier or as a center for a subsequent separation process (col. 4, lines 19-22). Importantly, this motivation could be used for the rest of the prior art references as well. Applicant never addresses this motivation but rather spends time arguing that the size of Speakman's recess is not met by the claim limitations. However, as alluded to previously, these dimensions appear arbitrary and can be treated as (1) an obvious matter of design or, more specifically, (2) as an element (a cone-shaped recess) which has only changed in size which is generally recognized as being within the level of ordinary skill in the art. In *Re Rose*, 105 USPQ 237, (CCPA 1955). Similarly, with respect to the Tajima reference, Applicant's argument that the depth of the hole disqualifies the reference is not convincing because it is within the ability of someone having ordinary skill in the art to provide a shallower screw hole while maintaining the fulfillment of the intention of the invention. With regard to Neill, Applicant improperly mandates that the entirety of a secondary reference must be imported into the primary reference by arguing that the primary reference must have all the separate parts that the Neill reference contains. Examiner disagrees and believes that a portion of the rivet joint (around 40 and 36) is a separable element that can be imported into the primary reference. With respect to the Takayama reference, Applicant regards the manner in which the recess comes about to be a controlling factor preventing any combination of references. Examiner disagrees. The fact that a cone-shaped recess is present in the reference is what matters, not how the cone-shaped recess came about.